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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,343	11/12/2003	Roger A. Dulin	23638-040	6825

7590 01/02/2009  
MINTZ, LEVIN, COHN, FERRIS,  
GLOVSKY and POPEO, P.C.  
One Financial Center  
Boston, MA 02111

EXAMINER
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SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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01/02/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/706,343	<b>Applicant(s)</b> DULIN ET AL.	
	<b>Examiner</b> Betelhem Shewareged	<b>Art Unit</b> 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-21 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-21 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's response along with the Request for Continued Examination (RCE) filed on 11/06/2008 has been fully considered. The 35 UCS 102 rejection has been withdrawn in view of Applicant's amendment. Claims 15, 17, 19, 21 and 23-26 are amended, claims 1-14 and 22 are canceled, and claims 15-21 and 23-26 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 15-21 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. (US 6,123,253) in view of Mehta (US 6,103,355).

4. Mehta '253 teaches a business form or mailer comprising a substrate sheet with a first end (meets the claimed top edge), a second end (meets the claimed bottom edge), a first side edge and a second side edge. One or more fold lines traversing a width of the sheet to form one or more panel sections. A line of weakening disposed longitudinally along the first side edge of the sheet to define a first marginal strip between the line of weakening and the first side edge, and a line of weakening disposed longitudinally along the second side edge to define a second marginal strip between the line of weakening and the second side edge. Adhesive patterns are disposed longitudinally along each of the first and second marginal strips; and along the first end

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of the sheet. (See Figs. 1 and 2, and col. 4, line 48 thru col. 5, line 64). The sheet further comprises a feed strip with a plurality of feed holes attached to each of the first and second side edges (Fig. 8 and col. 9, line 53). The business form or mailer further comprises an insert and/or a return envelope incorporated with the sheet (col. 8, lines 52-65 and col. 9, line 2). The sheet also comprises a transparentized viewing area located on a predetermined position of the sheet and formed on an exterior surface of the mailer (col. 7, line 31). The process by which the transparentized viewing area is formed is not dispositive of the issue of the instant article claims. Mehta '253 does not teach the sheet contains font images on the transparentized viewing area. However, Mehta '355 teaches a mailer or envelope which has at least one transparentized portion (abstract). The mailer or envelope comprises a substrate having a lower surface and an upper surface, and a reverse image is printed on the lower surface transparentized portion (col. 8, lines 45-47). The transparentized portion is highly receptive to inks and/or toners to allow a reverse image to be printed on the lower surface of the transparentized portion (col. 26, line 44). The reverse image can be printed with any conventional printing means (col. 27, line 30). Mehta '253 and Mehta '355 are analogous art because they are from the same field of endeavor that is the mailer or envelope art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the transparentized portion having ink receiving surface of Mehta '355 with the invention of Mehta '253, and the motivation would be, as Mehta '355 suggests, to allow a reverse image to be printed on the lower surface of the transparentized portion (col. 26, line 47), and applying reverse images on a back

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surface of a transparentized portion of a substrate is well known in the art (see col. 27, line 25 of Mehta '355).

5. With respect to claims 22 and 23, Mehta '253 teaches the claimed invention except the location of the transparentized viewing area. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to have the transparentized viewing area between the first end and the one or more fold lines, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

6. With respect to claim 24, Mehta '253 teaches the claimed invention except for the continuous line of adhesive along the first side edge and second side edge. It would have been obvious matter of design choice to have continuous line of adhesive along the first side edge and second side edge, since applicant has not disclosed that continuous line of adhesive along the first side edge and second side edge solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the adhesive patterns along the first side edge and second side edge

7. With respect to claims 25 and 26, Mehta '253 teaches having a return envelope toward the second end (Fig. 6, and col. 8, line 52-65).

### ***Response to Arguments***

8. Applicant's argument is based on that Mehta '253 does not teach or suggest a transparentizing area that is integral with the sheet, and Mehta '355 does not teach or

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suggest a translucent area including a receiving surface to receive printed data by a printing process. This argument is not persuasive for the following reason. Mehta '253 expressly teaches the sheet/mailer comprises a transparentized viewing area formed in an exterior surface of the mailer (col. 7, line 31), but does not teach the transparentized viewing area receives image or printed matter. However, Mehta '355 teaches the claimed printed transparentized portion/viewing area (col. 8, lines 45-47), wherein the transparentized portion is highly receptive to inks and/or toners to allow image to be printed on the lower surface of the transparentized portion (col. 26, line 44), and the image can be printed with any conventional printing means (col. 27, line 30). It would have been obvious to a person of ordinary skill in the art to combine the transparentized portion having ink receiving surface of Mehta '355 with the invention of Mehta '253, and the motivation would be, as Mehta '355 suggests, to allow a reverse image to be printed on the lower surface of the transparentized portion (col. 26, line 47), and applying reverse images on a back surface of a transparentized portion of a substrate is well known in the art (see col. 27, line 25 of Mehta '355).

9. For the above reason claims 15-21 and 23-26 stand rejected.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 9am-5pm.

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11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS

December 29, 2008

/Betelhem Shewareged/

Primary Examiner, Art Unit 1794